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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,378	11/08/2001	Ola Sandstrom	3782-0193P	5140
2292	7590	01/13/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			MUHEBBULLAH, SAJEDA	
			ART UNIT	PAPER NUMBER
			2174	
DATE MAILED: 01/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/986,378	Applicant(s) SANDSTROM ET AL.	
	Examiner Sajeda Muhebbullah	Art Unit 2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/14/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to Amendment filed 9/14/2004.
2. Claims 1-25 are pending in this application. Claims 1, 12, 18, 22, and 25 are independent claims. In the Amendment, claims 1, 4, 7-8, 11-12, 14, and 18 were amended and claims 21-25 were added. This action is made Final.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant needs to avoid using phrases such as "The present invention" and "means".

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 8, 10, 12-13 and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Sklarew (US 4,972,496).

As per claim 1, Sklarew teaches a filing appliance comprising means for holding a plurality of sheets (col.3, lines 37-40) wherein at least one input field (Fig.12c) is provided with

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a position-coding pattern (col.5, lines 61-64) and is adapted to be filled in by a drawing device (col.5, lines 57-60) which records, using said position-coding pattern, positions in the input field in order to digitally (col.7, line 38) record information entered in the input field (col.5, lines 61-67), and an initiation icon is provided (Fig.10, *SAVE*; Fig.12F, *INSERT*), wherein a detection of the initiation icon by the drawing device is adapted to initiate an operation in a computer system communicating with the drawing device, in which operation an information object is created (col.11, lines 41-43; col.12, lines 55-57), which is identifiable at least by means of information entered in the input field.

As per claim 2, Sklarew teaches the input field to be adapted to be filled in at least with text (col.12, lines 28-29).

As per claim 3, Sklarew teaches the input field to be adapted to be filled in at least with an illustration (col.4, lines 33-35).

As per claim 8, Sklarew teaches a filing appliance wherein in at least two sheets in a subset of said plurality of sheets are provided with a position-coding pattern, so that information filled in on a sheet in the subset can be recorded by said drawing device (col.5, lines 61-64) as a digital graphical input (col.7, lines 37-38), and a send icon provided with a position-coding pattern (Fig.12F, *INSERT*), a marking of the send icon by means of the drawing device initiating an operation in a computer system (col.12, lines 55-57), in which operation graphical inputs entered on the sheet are transferred to the computer system (col.3, lines 42-45) and optionally on to an external computer system (col.10, lines 53-57).

As per claim 10, Sklarew teaches a filing appliance wherein said information object comprises a file (col.10, lines 23-25; col.12, lines 55-57; *added text inserted into file*).

Independent claims 12 and 22 are individually similar in scope to independent claim 1, and are therefore rejected under similar rationale.

As per claim 13, Sklarew teaches the computer system to be integrated with the drawing device (Fig.2; col.5, lines 59-60).

As per claim 21, Sklarew teaches the filing appliance of claim 1, wherein the initiation icon is provided with a position-coding pattern (Fig.10, *SAVE*; Fig.12F, *INSERT*).

As per claim 23, Sklarew teaches the filing device wherein the information object electronically represents the filing device (col.10, lines 23-25; col.12, lines 55-57).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Gough et al. ("Gough", US 5,603,053).

As per claims 4-5, Sklarew teaches a filing appliance wherein in at least a subset of said plurality of sheets are provided with a position-coding pattern so that information filled in on a sheet in the subset by said drawing device (col.5, lines 61-64) is recordable as a digital graphical input (col.7, lines 37-38), the filing appliance comprising a number of icons (Fig.10). However, Sklarew does not disclose the filing appliance to comprise of a number of appearance icons, a marking of an appearance icon by means of said drawing device being adapted to give the digital graphical input a visual property. Gough teaches an appliance to be input by a drawing device

wherein the appliance comprises a number of appearance icons (Fig.2b, *icons 42, 44, 46*) which when marked provide the input a visual property relating to stroke weight (col.6, lines 23-28). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of Gough with Sklarew in order visually enhance the input of the user.

8. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Gough et al. ("Gough", US 5,603,053) in view of Microsoft PowerPoint ("PowerPoint").

As per claim 6, Sklarew and Gough teach the drawing device to give the digital input a visual property but does not disclose the visual property to relate to line color. However, PowerPoint teaches a drawing device adapted to give the input a line color (page 2, line color icon). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teaching of PowerPoint with the teaching of Sklarew and Gough in order to visually enhance the input of the user.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Borgstrom et al. ("Borgstrom", US 6,738,053).

As per claim 7, Sklarew teaches a filing appliance which comprises an address field provided with a position-coding pattern (Fig.2). However, Sklarew does not disclose an order icon, a marking of the order icon being adapted to initiate an operation in the computer system, which operation performs an order of another filing appliance to be delivered to the address entered in the address field. Borgstrom teaches a system for initiating functions using a drawing device wherein an order of additional sheets can be initiated through an icon (col.7, lines 51-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to

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include Borgstrom's teaching with Sklarew's apparatus in order to provide a quick and easy method of ordering appliances.

10. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Wildermuth (US 5,950,188).

As per claim 9, Sklarew teaches a filing appliance wherein said information object comprises a database (col.11, line 58; *character object added to database*). However, Sklarew does not explicitly disclose the database to be in the form of a table. Wildermuth teaches a computer system wherein a table in a database stores and retrieves information (col.5, lines 41-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Wildermuth's teaching with Sklarew appliance to increase the flexibility of modifying the data and make the database more user-friendly (Wildermuth, col.5, lines 55-58).

11. Claims 11, 14-15, 17 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) in view of Lamming (US 5,535,063).

As per claims 14-15 and 17, Sklarew teaches a filing appliance comprising an archiving icon (Fig.10, *SAVE*), a detection of the archiving icon by the drawing device initiates an operation wherein position information corresponding to strokes of the drawing device is transmitted from the drawing device to the computer system (col.5, lines 61-64; abstract, lines 6-8). However, Sklarew does not explicitly disclose the position information to be of strokes generated after a reference time point which is to be set to the current time in connection with the transmission of the position information and stored in the computer system. Lamming teaches a system of time-stamping strokes entered by a drawing device which are then stored in the computer system (col.2, lines 8-20). It would have been obvious to one of ordinary skill in the

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art at the time of the invention to include Lamming's teaching with Sklarew's system in order to provide a fast and efficient method of locating previously stored information.

Claims 11 and 24 are similar in scope to claim 14, and are therefore rejected under similar rationale.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Lamming (US 5,535,063) in view of Morishita et al. ("Morishita", US 6,335,727).

As per claim 16, the system of Sklarew and Lamming teaches the reference time point to be stored in the computer system, however, does not teach the reference time point to be stored in the drawing device. Morishita teaches a drawing device with the ability to store time points (col.13, lines 34-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Morishita's teaching with the system of Sklarew and Lamming in order to provide increased portability of positional information.

13. Claims 18-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sklarew (US 4,972,496) and Eichstaedt et al. ("Eichstaedt", US 6,563,494).

As per claim 18, Sklarew teaches a method for processing information comprising:
receiving position information from a drawing device, the position information being generated when the drawing device is moved over a position-coding pattern (col.5, lines 61-67), the position information including information that is generated before and after time point t (*time is continuous therefore inherent for a time to exist in which the position information is generated*);

However, Sklarew does not disclose inserting buffered position information generated before said time point t in a first information object wherein the first information object is related to a first filing appliance and inserting position information generated after said time point t in a second information object, wherein the second information object is related to a second filing appliance. Eichstaedt teaches a method of having multiple buffered position information generated before and after a time to be inserted into separate objects (Eichstaedt, col.5, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time of the invention to include Eichstaedt's teaching with Sklarew's method in order to use the drawing device for multiple applications.

Claims 19-20 and 25 are individually similar in scope to claim 18, and are therefore rejected under similar rationale.

Response to Arguments

14. Applicant's arguments with respect to claims 18-20 have been considered but are moot in view of the new ground(s) of rejection.

15. Applicant's arguments filed 9/14/2004 have been fully considered but they are not persuasive.

Applicant argued the following:

a) There is no teaching in Sklarew that is directed to a drawing device which records positions in the input field using the position-coding pattern.

b) Sklarew appears to teach away from utilizing technology associated with "pen down" sensors, which is the sensor that is utilized in the disclosure of Borgstrom. As such, the

disclosure of Sklarew teaches away from the purported combination of references as asserted by the Examiner, these references are not combinable.

The Examiner disagrees for the following reasons:

Per a), Sklarew clearly teaches the device to record positions using the positional coordinates from the screen (col.5, lines 57-67).

Per b), Sklarew does not teach away from the Borgstrom teaching. As clearly stated in the Sklarew reference, pen down sensors are taught (Sklarew, col.13, lines 11-31) therefore Sklarew and Borgstrom are combinable.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Communications

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sajeda Muhebbullah whose telephone number is (571) 272-4065. The examiner can normally be reached on Tuesday/Thursday from 8:00 am to 4:30 pm (EST) and on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (571) 272-4063.

The fax number for the organization where this application or proceeding is assigned are as follows:

(703) 746-7238 [After Final Communication]

(703) 872-9306 [Official Communication]

(703) 746-9915 [For status inquiries, Draft Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Sajeda Muhebbullah
Patent Examiner
Art Unit 2174

Kristine Kincaid
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